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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,407	06/19/2007	Karsten Hoffhaus	811844	5417
95402 7590 02/17/2011 LEYDIG, VOIT AND MAYER TWO PRUDENTIAL PLAZA, SUITE 4900 180 NORTH STETSON AVENUE CHICAGO, IL 60601			EXAMINER BRINSON, PATRICK F	
			ART UNIT 3754	PAPER NUMBER
			NOTIFICATION DATE 02/17/2011	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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LEYDIG, VOIT AND MAYER
TWO PRUDENTIAL PLAZA, SUITE 4900
180 NORTH STETSON AVENUE
CHICAGO IL 60601

In re Application of:
HOFFHAUS, KARSTEN et al
Serial No.: 10/576,407
Filed: June 19, 2007
Docket: 811844

DECISION ON PETITION

Title: PIPE SEGMENT FOR A TRANSFER
LINE FOR TRANSPORTING HOT
PARTICULATE MATERIAL

This is a decision on the petition filed on Feb. 8, 2011 by which petitioner requests reconsideration and withdrawal of the restriction requirement mailed Sep. 28, 2010, and that non-elected claims 25-29 be rejoined and examined on the merits. Claims 1-24 were elected for prosecution. This petition is being considered pursuant to 37 CFR 1.144 and 37 CFR 1.181, and no fee is required.

The petition is DISMISSED.

A review of the record reveals that on September 28, 2010, a restriction requirement was made under 35 USC 121 and 372 between two disclosed and claimed inventions: I) claims 1-24 drawn to a pipe segment, II) claims 25-29 drawn to a process for transporting a hot particulate material in a carrier gas. This application was filed under 35 USC 371 and therefore the groups of inventions must be shown to be not so linked as to form a single general inventive concept under PCT Rule 13.1.

Petitioner argues that Groups I and II inventions relate to a single general inventive concept under PCT Rule 13.1. The claimed process Invention of Group II do require the particular structure recited in the apparatus Invention of Group I. Therefore, petitioner opines that the restriction mailed on September 28, 2010 was improper.

Relevant portions of MPEP 1850 Unity of Invention, states [emphasis added below]:

An international application should relate to only one invention or, if there is more than one invention, the inclusion of those inventions in one international application is only permitted if all inventions are so linked as to form a single general inventive concept (PCT Rule 13.1). With respect to a group of inventions claimed in an international application, unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" is defined in PCT Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).

Whether or not any particular technical feature makes a "contribution" over the prior art, and therefore constitutes a "special technical feature," should be considered with respect to novelty and inventive step. For example, a document discovered in the international search shows that there is a presumption of lack of novelty or inventive step in a main claim, so that there may be no technical relationship left over the prior art among the claimed inventions involving one or more of the same or corresponding special technical features, leaving two or more dependent claims without a single general inventive concept.

Lack of unity of invention may be directly evident "*a priori*," that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*," that is, after taking the prior art into consideration. For example, independent claims to A + X, A + Y, X + Y can be said to lack unity *a priori* as there is no subject matter common to all claims. In the case of independent claims to A + X and A + Y, unity of invention is present *a priori* as A is common to both claims. **However, if it can be established that A is known, there is lack of unity *a posteriori*, since A (be it a single feature or a group of features) is not a technical feature that defines a contribution over the prior art.**

In judging the propriety of the restriction requirement, a lack of unity of invention must be either directly evident "*a priori*", that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*", that is, after taking the prior art into consideration.

The examiner indicated in the restriction requirement that the inventions listed as Groups I-II did not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features. The examiner stated that Group II invention does not require the particular structure recited in the invention of Group I, including providing an outer pipe section, an inner pipe section, support means supporting the inner pipe section so that the inner pipe section can expand axially relative to the outer pipe section, as required by the Group I invention.

MPEP 1850 clearly states that "Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims." [emphasis added]. The examiner should bear in mind that a claim may also contain a reference to another claim even if it is not a dependent claim as defined in PCT Rule 6.4. One example of this is a claim referring to a claim of a different category (for example, "Apparatus for carrying out the process of Claim 1 ...," or "Process for the manufacture of the product of Claim 1 ..."). Similarly, a claim to one part referring to another cooperating part, for example, "plug for cooperation with the socket of Claim 1 ..." is not a dependent claim.

After the examiner issued the restriction requirement and the applicant elected the group I invention (claims 1-24), the examiner issued a first action on the merits, non-final Office action dated December 8, 2010. In the non-final Office action, the examiner rejected the elected independent claim 1 as being anticipated by Stonitsch et al (USP 4,084,842). Claim 1 was the only independent claim in the elected group I.

Therefore, it became apparent "*a posteriori*", that is, after taking the prior art into consideration that lack of unity of invention exists. Because all of the features of claim 1 is known and does not avoid the prior art, there is no special technical feature that defines a contribution over the prior art that is common to all of the independent claims. In this situation, clearly there is lack of unity of invention.

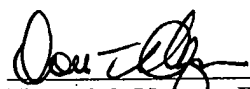
For the reasons outlined above, the examiner's restriction requirement is considered proper. Petitioner's request to have the restriction requirement withdrawn will not be granted.

Conclusion

For the reasons outlined above, the restriction requirement issued on September 28, 2010 is in accordance with proper Office procedure. Accordingly, the restriction requirement stands. The petitioner's request to withdraw the restriction requirement is dismissed.

The application is being forwarded to Supervisory Patent Examiner of Art Unit 3754 for further processing. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". Any inquiry regarding this decision should be directed to Henry C. Yuen, Quality Assurance Specialist, at (571) 272-4856.

The petition is DISMISSED.



Karen M. Young, Director
Technology Center 3700